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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MERLINO, ALYSON MARIE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,069	Applicant(s) KELLER ET AL.	
	Examiner Alyson M. Merlino	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges applicant's amendments to claims 1, 3-7, and 9-20, and the cancellation of claims 2 and 8.

Claim Objections

2. **Claim 1 is objected** to because of the following informalities:
 - a. In lines 12-14, the phrase "formed in such a way" is not clear and suggests a product by process limitation. The examiner suggest rephrasing lines 12-14 in a manner such as the following: "wherein the security key mechanical part is fitted with at least one second data storage module..."
 - b. In lines 12-18, the limitations recited are suggesting the process in which the cap is connected to the key and houses the electrical components. A rephrasing of these limitations is suggested since they are considered product-by-process limitations.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Regarding claims 1 and 16**, the phrase "can be or is" or "is or can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-7 and 9-20 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Lerchner et al. (US-5878611) in view of Leuling et al. (WO02075669) in further view of Howard (US-6928845).

8. **In regards to claim 1**, Lerchner et al. discloses an electronic locking device having at least one lock unit 29 and a security key 2 that has at least one first data storage module 20 which has an antenna 22. Lerchner et al. also discloses that the security key includes a control circuit and transmitting and receiving circuit which transmits information signals to the control circuit 30 of the other respective unit that is contained in one unit with the storage module 20 (Col. 3, lines 17-21 and lines 33-40).

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Lerchner further discloses that the security key has a mechanical part (cross-hatched portion in Figure 3) with a shank (portion of mechanical portion starting at reference character 10 and moving to the right towards reference character 5, Figure 1), a head (top part of mechanical part with hole, Figure 3). The first data storage module is inserted into a recess 25 in the mechanical part. Lerchner et al. discloses the first data storage module, but lacks at least a second data storage module that can be or is fitted in another recess 25' symmetric to the recess having the first data storage module with its own antenna and operates at a different frequency than that of the first module.

Leuling et al. teaches a security key 1 having two data storage modules 7, 8 capable of operating at two different frequencies (paragraph 11 of the translation). Since the security key disclosed by Lerchner et al. has a second recess for capable of holding a second data storage module and Leuling et al. teaches the use of two data storage modules with two different frequencies in a security key, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add another data storage module to the key disclosed by Lerchner et al. since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

9. Lerchner et al in view of Leuling et al. discloses a cap 3, 13 into which at least the second data storage module is adapted to be inserted on the mechanical part (Figure 3). Lerchner in view of Leuling et al. fails to disclose that the cap is latched onto the mechanical part. Howard teaches a cap for a key that latches onto the mechanical part of the key through its contoured edges conforming to the key's shape (Figure 8). Since the modification of the cap taught by Lerchner in view of Leuling et al. to have

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contoured edges to latch onto the mechanical part of the key would not affect the key's ability to actuate a lock, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the edges in order to ensure that the cap remains on the key for protection of the electrical components of the key and for identification purposes.

10. **In regards to claim 3**, Lerchner et al in view of Leuling et al. discloses that the cap is integrally produced from plastic (Col. 3, lines 33 and 34).

11. **In regards to claim 4**, within the last line of the claim dealing with pushing the cap onto the mechanical part via the shank, this limitation has functional language, and will not be given patentable weight.

12. **In regards to claims 5 and 6**, Lerchner et al in view of Leuling et al. discloses that the head of the mechanical part is smaller at the bottom (portion of head near reference character 10, Figure 1) and at least the second data storage module is arranged in this region next to the shank, specifically, the second data storage module in a pocket (area around 25', Figure 3) when assembled within the cap (Figure 3).

13. **In regards to claim 7**, within the third line of the claim dealing with placing the cap onto the mechanical part, this limitation has functional language, and will not be given patentable weight. However, Lerchner et al. in view of Leuling et al. discloses that the second data storage module is insertable into the cap when placed in the pocket during assembly (assembled key in Figure 3), as described in reference to claims 5 and 6, therefore, the limitation is met.

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14. **In regards to claim 9**, Lerchner et al in view of Leuling et al. discloses that on at least one narrow side (side with first data storage module and antenna, Figure 3) the mechanical part has a milled section 3 for accommodating the antenna 22 of the first data storage module (Figure 3).

15. **In regards to claim 10**, Lerchner et al in view of Leuling et al. discloses that the security key can include first and second data storage modules operating at different frequencies. Leuling et al. further teaches that the different frequencies of the two data storage modules allow them to affect different components within an electronic locking device (paragraphs 23 and 24 of the translation), therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the second data storage module be capable of affecting a different component of the electronic locking device than the lock unit affected by the first data storage module since it is well-known to use different frequencies for different situations, i.e. send a signal to actuate an access control unit instead of a lock, as taught by Leuling et al.

16. **In regards to claim 11**, Lerchner et al in view of Leuling et al. discloses the security key as applied to claim 1 above, and further discloses that the security key, specifically disclosed in Lerchner et al., is a conventional key used with a conventional cylinder lock having mechanical tumblers (Col. 1, lines 58-67 and Col. 2, lines 1-5). Therefore, since Lerchner et al. discloses that the security key is a conventional cylinder lock, it obviously has control areas on the shank for engagement with and actuation of the mechanical tumblers.

17. **In regards to claim 12**, Lerchner et al in view of Leuling et al. discloses that at the side, next to the shank, a cap 3, 13 has at least one recess (area around recess 25', Figure 3) for accommodating at least the second data storage module, is placed on the mechanical part (cross-hatched portion in Figure 3 and portion shown in Figure 2).

18. **In regards to claim 13**, Lerchner et al in view of Leuling et al. discloses that the cap is integrally produced from plastic (Col. 3, lines 33 and 34).

19. **In regards to claim 14**, within the last line of the claim dealing with pushing the cap onto the mechanical part via the shank, this limitation has functional language, and will not be given patentable weight.

20. **In regards to claims 15 and 16**, Lerchner et al in view of Leuling et al. discloses that the cap has laterally protruding regions beneath the head of the mechanical part (areas of cap containing antenna 21, 22 and first data storage module 20, Figures 2 and 3), and at least the second data storage module is arranged in at least one of said lateral regions (opposite placement of first data storage module, Figure 3). Lerchner et al in view of Leuling et al. further discloses at least two recesses (areas around recesses 25 and 25', Figure 2) into each of which a data storage module is or can be inserted.

21. **In regards to claim 17**, within the last line of the claim dealing with pushing the cap onto the mechanical part via the shank, this limitation has functional language, and will not be given patentable weight.

22. **In regards to claims 18 and 19**, Lerchner et al in view of Leuling et al. discloses that the head of the mechanical part is smaller at the bottom (portion of head near

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reference character 10, Figure 1) and at least the second data storage module is arranged next to the shank, specifically, the second data storage module in a recess (area around 25', Figure 3) when assembled within the cap (Figure 3).

23. **In regards to claim 20**, within the third line of the claim dealing with placing the cap onto the mechanical part, this limitation has functional language, and will not be given patentable weight. However, Lerchner et al. in view of Leuling et al. discloses that the second data storage module is insertable into the cap when placed in the pocket during assembly (assembled key in Figure 3), as described in reference to claims 18 and 19, therefore, the limitation is met.

Response to Arguments

24. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

25. Regarding the rejection of newly amended claim 1, after further review the limitation of claim 8 included in newly amended claim 1 is not considered allowable at this time.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyson M. Merlino whose telephone number is (571) 272-2219. The examiner can normally be reached on Monday through Friday, 7:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on (571) 272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMJ
August 5, 2007


JENNIFER H. GAY
SUPERVISORY PATENT EXAMINER